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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/638,404

08/12/2003

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08/02/2007

EXAMINER

GILBERT, ANDREW M

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

08/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/638,404	<b>Applicant(s)</b> ECKSTEIN ET AL.	
	<b>Examiner</b> Andrew M. Gilbert	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 5-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgments***

1. This office action is in response to the Response to Election/Restriction filed on 5/9/2007 in response to a Requirement for Restriction/Election mailed on 4/10/2007.
2. Additionally, in the reply the Applicant cancelled claim 20 and added new claims 21-22.

### ***Election/Restrictions***

3. Applicant's election of Group II: Claims 19, 21-22 in the reply filed on 5/9/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 1-3, 5-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/9/2007.
5. Thus claims 19, 21-22 are pending for examination.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Jeyendran (5536243). Jeyendran discloses a method of delivering a drug preparation to a

subject's body, comprising: introducing into the vagina (V, Fig 1) of a female a motorized syringe, containing a semen preparation (abstract) in an expansible-contractible chamber (16, 17); introducing into the uterus (U, Fig 1) of the female a flexible catheter tube (12) connected to an outlet (15) of said motorized syringe; and energizing said motorized syringe (col 5, lns 66-col 6, lns 21; col 7, lns 4-13; wherein the Examiner notes that Webster's defines a motor as "any of a various power unites that develop energy or impart motion" and thus in the instant case the expansion means (22) act by becoming energized via contact with water and act to develop energy and impart motion driving the plunger 18) to contract said chamber (16, 17) so as to deliver said semen preparation to said uterus at a slow flow rate for a prolonged period of time measured in hours (abstract).

8. Claims 19, 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Muharib (5904665). Muharib discloses a method of delivering a drug preparation to a subject's body, comprising: introducing into the vagina of a female a motorized syringe (abstract; 32, 36), containing a semen preparation (summary) in an expansible-contractible chamber (32, 36); introducing into the uterus of the female a flexible catheter tube (30) connected to an outlet (25, 32) of said motorized syringe; and energizing said motorized syringe (32, 36) to contract said chamber so as to deliver said semen preparation to said uterus at a slow flow rate for a prolonged period of time measured in hours (abstract; summary; col 2, lns 41-col 4, lns 17); wherein the subject's body is the vagina of a female; the drug preparation is a semen preparation; and wherein, before the electrical motor is electrically energized (32, 36; col 2, lns 41-col 4,

Ins 17), a flexible catheter tube (30) connected to an outlet (25, 32) of the syringe is introduced into the uterus of the female; wherein the power supply and control (36) for the electrical motor (36) in said syringe is contained within a separate unit attached to an external part of the subject's body and connected to said syringe by an electrical conductor (Fig 3; col 2, Ins 41-col 4, Ins 17).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 19, 21-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 2003/0176763; 6116193.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Andrew Gilbert

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER  
